

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
HAGLER et al.

Serial No. 09/668,623

Filed: September 22, 2000

For: *System and Method for Auto-
Configuration of a DSL Modem*

Attorney Docket No. 10547-011-999

Date: April 3, 2001

FAX RECEIVED

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PETITIONS OFFICE

DECLARATION OF DION M. BREGMAN UNDER 37 C.F.R. §1.47

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

I, DION M. BREGMAN declare that:

1. I am the attorney who prepared the above-identified application. In this application and in this petition under 37 C.F.R. §1.47, I am representing the interests of Telocity Delaware, Inc.

2. Upon information and belief, the subject matter of the present invention was conceived and developed by Christopher S. Hagler and Adam Powers ("the inventors") while each was employed by Telocity Delaware, Inc. Christopher S. Hagler has signed a declaration for the application and an assignment to Telocity Delaware, Inc. Adam Powers refuses to sign a declaration for the application. Furthermore, Adam Powers refuses to sign an assignment to Telocity Delaware, Inc.

3. Adam Powers is obligated, by agreement with Telocity Delaware, Inc. to assign his entire interest in the subject matter of the present invention to Telocity Delaware, Inc. A copy of the "Employee Inventions and Proprietary Rights Assignment Agreement" signed by Adam Powers on March 25, 1999, is enclosed herewith as *Exhibit A*. Section 1.9 of the attached employment agreement specifies Mr. Powers' obligation to assign inventions to MachOne

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Communications, Inc. By virtue of an asset purchase agreement in March 1999, Telocity, Inc. acquired the rights previously held by MachOne Communications, Inc. Telocity, Inc. was merged into Telocity Delaware, Inc. on March 27, 2000. Therefore, Telocity Delaware, Inc. is the successor in interest to all right's previously held by MachOne Communications, Inc.

4. After being reviewed by the inventors, a non-provisional Patent application was filed on September 22, 2000 with an unsigned Declaration.

5. On or about November 3, 2000, Mr. Powers left the employ of Telocity Delaware, Inc.

6. On December 12, 2000, after receiving a serial number from the U.S. Patent and Trademark Office, I sent a first package containing a letter, the filed application, a declaration document, and an assignment document (including serial number and filing date) to Adam Powers with a request that he read and sign the application. The first package was sent to Mr. Powers at his last known residential address of 630 Park View Drive, Apt. 108, Santa Clara, CA 95054, by certified mail. On January 29, 2001, the package was returned to me by the U.S. postal service as being unclaimed. A copy of the letter, Receipt for Certified Mail, and returned envelope are enclosed herewith as **Exhibit B**.

8. On January 11, 2000, after tracking down Mr. Powers' new work address, I sent to Mr. Powers' a second package containing a cover letter, the filed application, a declaration document, and an assignment document (including serial number and filing date) with a request that he read and sign the application. The second package was sent to Mr. Powers at his new work address of NURON, 122 Saratoga, Santa Clara, CA 95051, by Federal Express. The letter and enclosed documents were signed for by M. Holstien on January 12, 2001. A copy the letter, Federal Express receipt, and an email from Federal Express confirming receipt of the letter, are enclosed herewith as **Exhibit C**.

9. Subsequent to sending the second package I telephoned Mr. Powers a number of times at (408) 674-5865. On one occasion that I managed to speak with Mr. Powers he informed

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me that he indeed received the second package, but that he was unwilling to sign the declaration and/or the assignment documents.

10. I have subsequently left a number of voicemail messages for Mr. Powers at the above number, clearly explaining the urgency of filing the signed declaration. None of my voicemail messages have been returned by Mr. Powers.

11. As indicated in paragraphs 8 and 9, the last known work address of Mr. Powers is NURON, 122 Saratoga, Santa Clara, CA 95051, and his last known residential telephone number is (408) 674-5865. We have been unable to obtain a current residential address.

12. Based on a telephone conversation with a company representative of Telocity Delaware, Inc., I was informed that Mr. Powers is a U.S. citizen.

13. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. I further declare that all statements made by me herein are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that any willful false statements may jeopardize the validity of any patent resulting therefrom.

Respectfully submitted,

PENNIE & EDMONDS LLP

By: 

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